



5-8-06

Tfu\$

PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**TRANSMITTAL  
FORM**

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

9

Application Number

10/617,489

Filing Date

July 10, 2003

First Named Inventor

Thomas L. CANTOR

Art Unit

1641

Examiner Name

C. Cheu

Attorney Docket Number

532212000623

**ENCLOSURES (Check all that apply)**☒ Fee Transmittal Form (1 page plus duplicate)☐ Fee Attached☐ Amendment/Reply☐ After Final☐ Affidavits/declaration(s)☐ Extension of Time Request☐ Express Abandonment Request☒ Information Disclosure Statement (4 pages)☐ Certified Copy of Priority Document(s)☐ Reply to Missing Parts/Incomplete Application☐ Reply to Missing Parts under 37 CFR 1.52 or 1.53☐ Drawing(s)☐ Licensing-related Papers☐ Petition☐ Petition to Convert to a Provisional Application☐ Power of Attorney, Revocation Change of Correspondence Address☐ Terminal Disclaimer☐ Request for Refund☐ CD, Number of CD(s) \_\_\_\_\_☐ Landscape Table on CD☐ After Allowance Communication to TC☐ Appeal Communication to Board of Appeals and Interferences☐ Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)☐ Proprietary Information☐ Status Letter☒ Other Enclosure(s) (please identify below):PTO/SB/08a/b Form (1 page plus duplicate)  
References (7)  
Return Receipt Postcard

Remarks

CUSTOMER NO. 25225

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm Name

MORRISON &amp; FOERSTER LLP

Signature

Printed name

Peng Chen

Date

May 5, 2006

Reg. No.

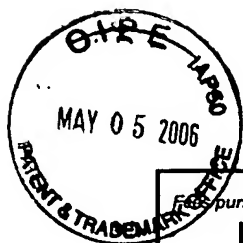
43,543

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 743885379 US, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: May 5, 2006

Signature:

(Lenay Rogus)



PTO/SB/17 (01-06)

Approved for use through 7/31/2006. OMB 0651-0032

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no person are required to respond to a collection of information unless it displays a valid OMB control number.

Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

**FEE TRANSMITTAL**  
**For FY 2006****Complete if Known**

<input checked="" type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27	Application Number	10/617,489	
TOTAL AMOUNT OF PAYMENT (\$)	Filing Date	July 10, 2003	
	First Named Inventor	Thomas L. CANTOR	
	Examiner Name	C. Cheu	
	Art Unit	1641	
(\$)	180.00	Attorney Docket No.	532212000623

**METHOD OF PAYMENT** (check all that apply)

<input type="checkbox"/> Check	<input type="checkbox"/> Credit Card	<input type="checkbox"/> Money Order	<input type="checkbox"/> None	<input type="checkbox"/> Other (please identify): _____
<input checked="" type="checkbox"/> Deposit Account	Deposit Account Number: 03-1952		Deposit Account Name: Morrison & Foerster LLP	
For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)				
<input checked="" type="checkbox"/> Charge fee(s) indicated below	<input type="checkbox"/> Charge fee(s) indicated below, except for the filing fee			
<input checked="" type="checkbox"/> Charge any additional fee(s) or underpayment of fee(s) under 37 CFR 1.16 and 1.17	<input checked="" type="checkbox"/> Credit any overpayments			

**FEE CALCULATION** (All the fees below are due upon filing or may be subject to a surcharge.)**1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

**2. EXCESS CLAIM FEES**

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

<u>Total Claims</u>	<u>Extra Claims</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>	<u>Multiple Dependent Claims</u>	
_____ - 20 = _____	x _____	= _____		<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>

HP = highest number of total claims paid for, if greater than 20.

<u>Indep. Claims</u>	<u>Extra Claims</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>
_____ - 3 = _____	x _____	= _____	

HP = highest number of independent claims paid for, if greater than 3.

**3. APPLICATION SIZE FEE**

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

<u>Total Sheets</u>	<u>Extra Sheets</u>	<u>Number of each additional 50 or fraction thereof</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>
_____ - 100 = _____	/50	_____ (round up to a whole number) x _____	= _____	

**4. OTHER FEE(S)**

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): 1806 Submission of an Information Disclosure Statement 180.00

<b>SUBMITTED BY</b>			
Signature		Registration No. (Attorney/Agent)	43,543
Name (Print/Type)	Peng Chen	Telephone	(858) 720-5117
		Date	May 5, 2006



I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 743885379 US, in an envelope addressed to MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: May 5, 2006      Signature: *Lenay Rogus*  
(Lenay Rogus)

Patent  
Docket No. 532212000623

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Thomas L. CANTOR

Serial No.: 10/617,489

Filing Date: July 10, 2003

For: METHODS, KITS AND ANTIBODIES  
FOR DETECTING PARATHYROID  
HORMONE

Examiner: C. Cheu

Group Art Unit: 1641

**SUPPLEMENTAL INFORMATION DISCLOSURE  
STATEMENT UNDER 37 C.F.R. § 1.97 & 1.98**

MS Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Dear Sir:

Pursuant to 37 C.F.R. § 1.97 and § 1.98, Applicant submits for consideration in the above-identified application the documents listed on the attached Form PTO/SB/08a/b. Copies of the documents are also submitted herewith. The Examiner is requested to make these documents of record.

Document numbers 1 and 2 are from the *Ex Parte* Reexamination proceeding of US Patent No. 6,689,566, having Control Numbers 90/007,685 and 90/007,732. Document No. 1 is a first Office Action issued in the reexamination. Document No. 2 is cited in the first Office Action and has not been submitted and/or considered in the prosecution of the present application. The

present application is a Continuation-in-Part (CIP) of US Patent No. 6,743,590, which is a CIP of US Patent No. 6,689,566.

Document numbers 3-5 are further publication evidences of the MAGERLEIN et al., European Journal of Pharmaceutical Sciences (1994) Vol. 2 pt. ½ at 154 (Magerlein Abstract), which was submitted in the May 10, 2005 Supplemental IDS (Document No. 35) and the Examiner considered the Magerlein Abstract in the Office Action mailed on December 5, 2005. Document No. 3 is a receipt stamp from the National Diet Library of Japan which apparently shows that the September 1994 issue of the European Journal of Pharmaceutical Sciences was received by the library on September 26, 1995. Document No. 4 is a note from the Bibliotheque Interuniversitaire de Pharmacie in Paris which apparently indicates that the library received the September 1994 issue of the European Journal of Pharmaceutical Sciences on September 27, 1994. Document No. 5 is a copied register received from the Bibliotheque Universitaire Lyon, France which apparently indicates that the library received the September 1994 issue of the European Journal of Pharmaceutical Sciences on September 21, 1994.

Document numbers 6 and 7 are from *Nichols Institute Diagnostics, Inc. v. Scantibodies Clinical Laboratory, Inc. and Scantibodies Laboratory, Inc.*, U.S.D.C. for the Southern District of California, case number 02 CV 0046 B (JMA), currently on appeal at the United States Court of Appeals for the Federal Circuit.

This Information Disclosure Statement is submitted:

- ☐ With the application; accordingly, no fee or separate requirements are required.
- ☐ Before the mailing of a first Office Action after the filing of a Request for Continued Examination under § 1.114. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☐ Within three months of the application filing date or before mailing of a first Office Action on the merits; accordingly, no fee or separate requirements are required. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.

- ☒ After receipt of a first Office Action on the merits but before mailing of a final Office Action or Notice of Allowance.
- ☐ A fee is required. A check in the amount of \_\_\_ is enclosed.
- ☒ A fee is required. Accordingly, a Fee Transmittal form (PTO/SB/17) is attached to this submission in duplicate.
- ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above; accordingly, no fee is believed to be due.
- ☐ After mailing of a final Office Action or Notice of Allowance, but before payment of the issue fee.
- ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a check in the amount of \_\_\_ is enclosed.
- ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a Fee Transmittal form (PTO/SB/17 is attached to this submission in duplicate.)

Applicant would appreciate the Examiner initialing and returning the Form PTO/SB/08a/b, indicating that the information has been considered and made of record herein.

The information contained in this Information Disclosure Statement under 37 C.F.R. § 1.97 and § 1.98 is not to be construed as a representation that: (i) a complete search has been made; (ii) additional information material to the examination of this application does not exist; (iii) the information, protocols, results and the like reported by third parties are accurate or enabling; or (iv) the above information constitutes prior art to the subject invention.

In the unlikely event that the transmittal form is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief (such as payment of a fee under 37 C.F.R. § 1.17 (p)) is required, Applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petition and/or other

fees due in connection with the filing of this document to Deposit Account No. 03-1952  
referencing 532212000623.

Dated: May 5, 2006

Respectfully submitted,

By 

Peng Chen

Registration No.: 43,543  
MORRISON & FOERSTER LLP  
12531 High Bluff Drive  
Suite 100  
San Diego, California 92130-2040  
(858) 720-5117



ALTERNATIVE TO PTO/SB/08a/b (07-05)

<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b>  (Use as many sheets as necessary)				<b>Complete if Known</b>	
				Application Number	10/617,489
				Filing Date	July 10, 2003
				First Named Inventor	Thomas L. CANTOR
				Art Unit	1641
Sheet	1	of	1	Examiner Name	C. Cheu
				Attorney Docket Number	532212000623

U.S. PATENT DOCUMENTS					
Examiner Initials*	Cite No. <sup>1</sup>	Document Number Number-Kind Code <sup>2</sup> (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear

FOREIGN PATENT DOCUMENTS						
Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document Country Code <sup>3</sup> -Number <sup>4</sup> -Kind Code <sup>5</sup> (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T <sup>6</sup>

\*EXAMINER: Initial if information considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. <sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> See Kinds Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language Translation is attached.

NON PATENT LITERATURE DOCUMENTS			
Examiner Initials	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>2</sup>
	1.	Office Action in the Reexamination of US Patent No. 6,689,566, Control Numbers 90/007,685 and 90/007,732, mailed on April 20, 2006	
	2.	HARLOW and LANE, Antibodies: A Laboratory Manual, Cold Spring Harbor (1988) page 612	
	3.	Receipt stamp from the National Diet Library of Japan showing that the September 1994 issue of the European Journal of Pharmaceutical Sciences was received by the library on September 26, 1995	
	4.	Note from the Bibliotheque Interuniversitaire de Pharmacie in Paris indicating that the library received the September 1994 issue of the European Journal of Pharmaceutical Sciences on September 27, 1994	
	5.	The copied reister received from the Bibliotheque Universitaire Lyon, France indicating that the library received the September 1994 issue of the European Journal of Pharmaceutical Sciences on September 21, 1994	
	6.	Appellee Nichols' Brief, filed March 27, 2006	
	7.	Appellants Scantibodies' Reply Brief, filed April 21, 2006	

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> Applicant is to place a check mark here if English language Translation is attached.

Examiner Signature		Date Considered	
-----------------------	--	--------------------	--

sd-314611